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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,397	04/18/2001	Shuichi Kikuchi	10417-079001	7648

7590 09/13/2002

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EXAMINER

LEWIS, MONICA

ART UNIT

PAPER NUMBER

2822

DATE MAILED: 09/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/837,397

Applicant(s)

KIKUCHI ET AL.

Examiner

Monica Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This office action is in response to the application filed April 18, 2001.

***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-6, drawn to a semiconductor structure for a high sustaining voltage MOS transistor, classified in class 257, subclass 344.
  - II. Claims 7-12, drawn to the method for manufacturing a high sustaining voltage MOS transistor, classified in class 438, subclass 197.

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

A telephone call was placed to Chris T. Mizumoto on August 26, 2002 which resulted in a provisional election being made without traverse to prosecute the semiconductor structure for a high sustaining voltage MOS transistor, claims 1-6. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Specification***

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

***Drawings***

34. Figures 10-12 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-6 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-13 of Kikuchi et al. (U.S. Publication No. 2002/0094642A1). This is a double patenting rejection. In order to determine whether a statutory basis for a double patenting rejection exists, the question that has to be asked is: Is the same invention being claimed twice? 35 U.S.C. 101 prevents two patents from issuing on the same invention. See MPEP § 804. Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See Miller v. Eagle Mfg. Co., 151 U.S. 186 (1894); In re Ockert, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Therefore, we feel that the same invention has been disclosed in 09/837,397 and U.S. Publication No. 2002/0094642A1.

Claims may be worded in a different manner and still define the same invention. See MPEP § 804. For example, a claim reciting a widget having a length of “36 inches” defines the same invention as a claim reciting the same widget having a length of “3 feet.” *Id.* Therefore, there are several examples that can be illustrated to show that the same invention has been disclosed in 09/837,397 and U.S. Publication No. 2002/0094642A1.

The first example is as follows:

In regards to claim 1, application 09/837,397 discloses the following:

- a) a gate electrode formed on one conductive type semiconductor substrate through a gate insulation film;
- b) a high concentration reverse conductive type source region adjacent to one end of said gate electrode;
- c) a low concentration reverse conductive type drain region formed facing said source region through a channel region;
- d) a high concentration reverse conductive type drain region separated from the other end of said gate electrode and included in said low concentration reverse conductive type drain region; and
- e) a middle concentration reverse conductive type layer at a region spanning at least from the position having the predetermined space from said gate electrode to said high concentration reverse conductive type drain region, and formed so that high impurity concentration becomes lower at a region near the gate electrode than near said high concentration reverse conductive type drain region.

In regards to claim 1, U.S. Publication No. 2002/0094642A1 discloses the following:

- a) a gate electrode formed on one conductive type semiconductor substrate through a gate insulation film;
- b) a high concentration reverse conductive type source region adjacent to one end of said gate electrode;
- c) a low concentration reverse conductive type drain region formed facing said source region through a channel region;

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d) a high concentration reverse conductive type drain region separated from the other end of said gate electrode and included in said low concentration reverse conductive type drain region; and

e) a middle concentration reverse conductive type layer **having high impurity concentration peak at a position of the predetermined depth in said substrate** at a region spanning at least from the position having the predetermined space from said gate electrode to said high concentration reverse conductive type drain region, and formed so that high impurity concentration becomes low at a region **near surface of the substrate**.

The second example is as follows:

In regards to claim 2, application 09/837,397 discloses the following:

a) middle concentration reverse conductive type layer is formed at a region spanning **at least** from said gate electrode to said high concentration reverse conductive type drain region **so that the impurity concentration gradually becomes high from said gate electrode to said high concentration**.

In regards to claim 2, U.S. Publication No. 2002/0094642A1 discloses the following:

a) middle concentration reverse conductive type layer is formed at a region spanning from said gate electrode to said high concentration reverse conductive type drain region.

The only difference between the claims listed above is the highlighted words. Therefore, the same invention has been described even though the claims have been worded in a different manner.


The examples listed above are just a few that were selected out of application 09/837,397 and U.S. Publication No. 2002/0094642A1 to illustrate that the same invention has been disclosed.

*Conclusion*

7. Applicant is advised that should claims 2 and 5 be found allowable, claims 3 and 6 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica Lewis whose telephone number is 703-305-3743. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Whitehead, Jr. can be reached on 703-308-4940. The fax phone number for the organization where this application or proceeding is assigned is 703-308-7722 for regular and after final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

ML  
September 6, 2002

  
CARL WHITEHEAD, JR.  
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